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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,767	05/14/2001	Kenichi Hamanaka	P/1071-1329	8896

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EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 11/29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,767

Applicant(s)

HAMANAKA ET AL.

Examiner

Margaret B. Medley

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Applicant's election with traverse of Group I (claims 1-5) in Paper No. 7 is acknowledged. The traversal is on the ground(s) that it is not seem how the adhesive resin of Group I could be made by mixing ferrite powder with a cured matrix resin and achieve an adhesive composition. Further the classification of Group I and II are both class 524, subclass 430. This is not found persuasive because of the reason made of record in Paper No. 5 dated July 25, 2002 and applicants have not presented persuasive arguments that the composition adhesive cannot be made with a cured matrix resin.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ishino et al (Ishino) 4,116,906.

Ishino teaches a resin composition comprising 20-260 parts of ferrite powder, 40-680 parts iron powder of 1-300 microns size, 100 parts of an organic high molecular weight compound and 20-3000 parts of organic solvent that the organic compound is soluble therein, see column 2, lines 4-30 and claims 1, 3-4 and 6-7. Ishino clearly teaches that the organic compound include polyimide resins, see column 1, line 60, which anticipates instant claim 1-5 when the liquid matrix resin is (B) a resin having an imide bond and being capable of dissolving in a organic solvent.

If applicants deem the claims not to be anticipated, then in the alternative the instant claims are rendered obvious by the teaching of Ishino that the organic compounds include polyimide resins that are soluble in the organic solvent and comprises a dispersion of ferrite powder and iron powders contained in its solution, see column 1, lines 32-37.

The 20-260 parts of ferrite powder of Ishino overlaps the 200-1500 parts of ferric powder of instant claim 3 and therefore anticipates the lower range portion of instant claim 3. Thus since the components and the relative proportion of the composition of Ishino are the same as those of the instant the composition of Ishino is deemed to contain the same adhesive properties.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 01267363A, see the English Abstract.

The Japanese patentee teaches and discloses electrodes made of resin found magnetic composition containing 80-90 wt.% ferromagnetic powder and 5-20 wt.% high heat resistant thermosetting resin powder, e.g., prepolymer obtained from the reaction of the bisimide compound of unsaturated dicarboxylic acid with a polyamine compound having at least two amino groups, see the English abstract that clearly anticipates the instant claims. The composition of the Japanese reference is deemed to contain adhesive properties since the compositions contain the same components in the same relative proportion as those of the instant claims of record.

Claim 5 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tanino et al (Tanino) 4,808,326 or its EP 225,392 counterpart, see Examples 1-9 and 10 of Tables 1-2 that contains ferrite powders of 80-95 wt.% having a size of 50 to 300 mesh, 5-20 wt.% of thermosetting resin powder, e.g., polyimide produced by adding diaminodiphenylmethane to bismaleinide produced by reacting maleic anhydride with diaminodiphenylmethane, see column 5, lines 37-42, and a metal chelate that anticipate the instant claims.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP-2304A, see English Abstract for 100 g ferrite powder and 4 g of an organic adhesive, e.g., polyimide, that anticipates instant claims 1-3.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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Claims 1-5 are rejected under 35 U.S.C. 102(a) as being anticipated by Suzuki et al (Suzuki) 6,342,557 B1.

Suzuki teaches a resin composition and molded or formed product comprising 100 parts synthetic resin and 50 to 1,400 parts of a ferrite powder of 2 to 1,000 microns, see abstract, column 4, lines 17-21. Suzuki clearly teaches that the resin composition include polyimide resins, see column 4, lines 55-56, which anticipates the instant claims.

The 50 to 1,400 parts ferrite powder of Suzuki overlaps the 200-1,500 parts of ferrite powder of instant claim 3 and therefore anticipates the lower range portion of instant claim 3. Thus since the components and the relative proportion of the components of Suzuki are the same as those of the instant claims the composition of Suzuki is deemed to contain adhesive properties.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (Suzuki) 5,510,412.

Suzuki teaches a resinous composition comprising 80-95 wt.% of ferrite powder having particle size of 1-200 microns, see abstract and column 4, lines 4-5 and 5-20 wt.% of a resin component comprising 70-99.5 wt.% of a polyarylene sulfide resin and 0.5-30 wt.% of polyethylene wherein the resin component further comprises an additional resin, that include a resin containing an imide group, see column 3, lines 31-35 and 40-41. It is further disclosed that the additional resin is present in 29.5 wt.% of the total resin composition, see column 3, lines 42-45.

The 1.66-10 wt.% of the polyimide resin to 70-99.5 wt.% of ferrite of Suzuki overlaps the 100 parts wt. resin to 200-1500 parts wt. ferrite of instant claim 3 and thus render instant claims

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1-5 obvious. Since the components in the composition of Suzuki overlaps that of the instant claim, the composition of Suzuki is deemed to contain adhesive properties.

The prior art cited and not relied upon further teaches compositions comprising ferrite powders and matrix resin of the same or similar compositions as that of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. B. Medley/mn
November 25, 2002

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER